

### REMARKS

Claims 1-17 are cancelled without prejudice in favor of new Claims 18-33. Favorable reconsideration is respectfully requested.

At the outset, Applicants thank Examiner Yamnitzky for the courteous discussion of the present application held on May 22, 2003, as well as the many courteous discussions between May 22, 2003 and the filing of the present response, which are summarized and expanded upon below. Further, Applicants thank Examiner Yamnitzky and for her many helpful suggestions within the outstanding Office Action and during the above-mentioned discussions to overcome the rejections therein. Finally, Applicants thank Examiner Yamnitzky for not indicating that the outstanding Office Action as Final, and for indicating that the above amendment combined with the arguments below would favorably further prosecution of the present application.

The rejection of the claims under 35 U.S.C. § 102(b) and/or § 103(a) over Suzuki et al are believed to be obviated by the amendment above combined with the remarks below.

Suzuki et al disclose, at best, an adamantane compound having a core structure similar to structure (d) of Claim 18. As indicated within the above-mentioned discussion with the Examiner, the Office recognizes that this compound does not contain any other substituent other than hydrogen as R1-R8. Further, the Office recognizes that Suzuki et al fail to disclose that the aryl skeleton structure is not directly bonded to the adamantane core. Finally, the Office recognizes that Suzuki et al do not disclose the claimed aryl skeleton structures directly bonded or bridged to the adamantane core.

In spite of the Office's recognition of these failures within the disclosure of Suzuki et al, the Office indicates that it would be obvious to make modifications to the the structure

disclosed by Suzuki et al towards the claimed compounds. Applicants respectfully traverse the Office's position on the basis that Suzuki et al simply fails altogether to provide motivation to one reading its text to modify the compounds disclosed therein.

As admitted by the Office, the closest compound disclosed by Suzuki et al, at best, contains an adamantane core structure. However, that is all that may be similar between the claimed compounds and the compounds disclosed by Suzuki et al. For example, Suzuki et al fail to disclose a naphthyl structure bonded to the adamantane core whatsoever, while one of the claimed embodiments contains naphthyl substitutions on an adamantane core. Further, Suzuki et al fail disclose an adamantane core containing a substituted phenyl group, while one of the claimed embodiments of the present invention provides a di-substituted phenyl group moiety bonded to an adamantane core. Still further, Suzuki et al fail to disclose or suggest an adamantane compound containing two substituted phenyl moieties, while one claimed embodiment of the present invention relates to an adamantane compound containing two substituted phenyl moieties. Finally, Suzuki et al fail to disclose or suggest an adamantane compound containing a di-phenyl moiety containing an aryl skeleton directly bonded thereto, while one embodiment of the claimed invention relates to an adamantane compound containing a di-phenyl moiety containing an aryl skeleton directly bonded thereto.

In light of the above, the compounds of Suzuki et al and claimed the compounds are not even homologs of each other. The Federal Circuit has defined the parameters that may be considered in determining the proper use of chemical structure as the basis for obviousness rejections under 35 U.S.C. § 103 in *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992, enclosed herewith). The Court cited the following examples of relationships that have given rise to a prima facie case of obviousness, which in turn is the standard for obviousness-type double patenting:

triorthoesters and tetraorthoesters;  
stereoisomers;  
adjacent homologs and structural isomers; and  
acid and ethyl ester (Id., at 1943).

In the present case, there exists no motivation to modify the compounds disclosed by Suzuki et al to contain any of the claimed substituents of the claimed compounds because Suzuki et al is silent in this regard and because the relationship between the claimed compounds and those disclosed by Suzuki et al fail to satisfy any of the above-mentioned relationships to be defined as homologs by the Federal Circuit.

In light of the above, it appears as if the Office is relying on the Applicants disclosure to supply motivation to modify compounds disclosed by Suzuki et al to contain the claimed substituents in order to arrive at the claimed compounds. However, this simply can not be possible due the nature of the claimed adamantane compounds discussed above. Moreover, this is clearly improper procedure according to a recent decision by the U.S. Federal Courts in *In re Lee* (61 USPQ2d 1430). The *Lee* Court indicated that the Office must provide specific motivation, hint, or suggestion, found in the references relied upon to support a *prima facie* case of obviousness. In the present case, the Office appears to rely on the present specification for motivation, which is clearly forbidden according to the *Lee* Court. In light of this decision, Applicants respectfully request the Office not to use the present specification to find motivation that is not present in any of the disparate disclosure of the reference discussed herein. Accordingly, withdrawal of this ground of rejection is respectfully requested.

The rejection of the claims under 35 U.S.C. § 112, first and second paragraphs, are believed to be obviated by the cancellation of these claims. Further, in accordance with the

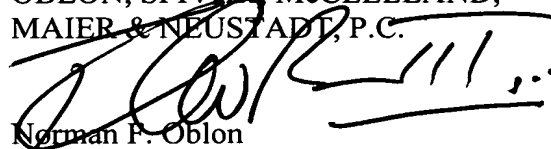
Examiner's suggestion, Applicants have added new claims which include symbol designations for each "R" group within the claimed compounds. These identifiers were inserted for the Examiner's convenience and to clarify the claimed invention. Support for the new Claims 18-33 is found in the originally filed specification and claims. More specifically, the bridging groups of the claimed aromatic substitutions are supported by the structures throughout the specification and claims originally filed. For example,  $\text{-HC=CH-}$  and  $\text{-N=N-}$ , etc are supported by formulas (r17) and (r4), respectively. Moreover, the structure of (r8) has been clarified and is supported in the originally filed specification. Finally, the misspelling of "furazalyl" and "chromelyl" has been corrected in accordance with the Examiner's suggestion, and "puritedinyl" has been removed altogether. No new matter is believed to be introduced by the new claims. Accordingly, withdrawal of these grounds of rejection is respectfully requested.

The objection to the disclosure of the invention is believed to be obviated by the above amendment. In accordance with the Examiner's suggestion, Applicants have clarified structures and chemical names throughout the specification and claims so as to agree with one another. Support for the amendments to the specification is found at pages 10, 18, 56, and 57 therein and the originally filed claims. No new matter is believed to be introduced by the amendment. Accordingly, withdrawal of this ground of objection is respectfully requested.

Applicants respectfully submit that the present application is now in condition for allowance. Early notice to this effect is respectfully requested. Should anything further be required to place this application in condition for allowance, the Examiner is requested to contact the undersigned by telephone.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Norman F. Oblon  
Attorney of Record  
Registration No. 24,618

Thomas W. Barnes III, Ph.D.  
Registration No. 52,595



**22850**

(703) 413-3000  
Fax #: (703) 413-2220  
NFO/JK/TWB/cja